



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,070	01/22/2002	Yasunobu Fujita	Q68238	3982

7590 03/11/2004

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

FOOTLAND, LENARD A

ART UNIT	PAPER NUMBER
----------	--------------

3682

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,070

Applicant(s)

FUJITA ET AL.

Examiner

Lenard A. Footland

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 8-12, 14-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-12, 14-20, 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5-6, 8-9

Claims 1-3, ~~5-9~~, 18-20, 22-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Uchiyama et al. in view of Johnstone et al.

The examiner finds that except for those shown by Johnstone et al., Uchiyama et al. discloses all of the claimed elements and functions. See col. 5, lines 44-51 and 61-63. See col. 5, line 26 for resin and col. 6, lines 10-12 for viscosity. The cage oil percentages are considered to generate volume percentages overlapping those claimed.

The examiner finds that the Johnstone et al. reference expressly discloses what Uchiyama et al. does not, the conventionality of providing lubricant in the non-cage claimed space percentages (see Fig. 2) in order to prevent bearing wear (col. 1, lines 29-38). Applying the test for obviousness set forth in *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), which is what the combined teaching of the references would have suggested to those of ordinary skill in the art, the examiner finds that one having

Art Unit: 3682

ordinary skill in the art would have found that providing the Uchiyama et al. bearing and lubricant in the claimed lubricant percentages, as taught by Johnstone et al., would have been obvious in view of the teaching of Johnstone et al. of doing so to prevent wear.

Claims 10-12, 14-17 and 24-25 are rejected under 35 U.S.C. § 103 as being unpatentable over Uchiyama et al. in view of ^{5-6, 8-9}Johnsone et al., as set forth in the rejection of claims 1-3, ~~5-9~~, 18-20, 22-23 above, and further in view of official notice of common knowledge in the art.

The examiner finds that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Uchiyama et al. ball bearing with lubricant, as modified by Johnsone et al., in a hard disk drive to facilitate its rotation and provide significant load-bearing capacity. See Mouri et al. Element 9a is an "actuator".

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lenard A. Footland, whose telephone number is (703) 308-2683.

Fax: 703-872-9326

A handwritten signature in cursive script, reading "Lenard A. Footland". The signature is fluid and includes a large, sweeping flourish at the end.

Lenard A. Footland
Primary Examiner
Technology Center 3600
Art Unit 3682

laf
March 9, 2004